UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/896,657	06/29/2001	Victor R. Herrero	POU920010051US1	8494

			EXAMINER
23334	7590	07/14/2004	ROCHE, TRENTON J

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ART UNIT	PAPER NUMBER
2124	

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _29 June 2001_.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-17_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-17_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _29 June 2001_ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _06292001_.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   This office action is responsive to communications filed 29 June 2001.

2.   Claims 1-17 have been examined.

Claim Objections

3.   Claim 4 is objected to because of the following informalities: there appears to be a grammatical error on line 2 during the phrase "is accomplished only when the need for the software file is needed...". Appropriate correction is required. For purposes of examination this will be interpreted to read "is accomplished only when the software file is needed…"

4.   Claim 9 is objected to because of the following informalities: there appears to be a grammatical error on line 3 during the phrase "receiving a request for the download a copy…". Appropriate correction is required. For purposes of examination this will be interpreted to read "receiving a request for the download of a copy…"

5.   Claim 15 is objected to because of the following informalities: there appears to be a grammatical error on line 4 during the phrase "from a client system for a copy of at the at least one…". Appropriate correction is required. For purposes of examination this will be interpreted to read "from a client system for a copy of the at least one…"

6.   Claim 15 is objected to because of the following informalities: there appears to be a grammatical error on line 7 during the phrase "down loading sending the payload". Appropriate correction is required. For purposes of examination this will be interpreted to read "sending the payload…"

7.   Claim 17 is objected to because of the following informalities: there appears to be a grammatical error on line 3 during the phrase "a network interface for couple one or more…".

Appropriate correction is required. For purposes of examination this will be interpreted to read "a network interface for coupling one or more..."

8.   Claim 17 is objected to because of the following informalities: there appears to be a grammatical error on line 4-5 during the phrase "the one or more client system...". Appropriate correction is required. For purposes of examination this will be interpreted to read "the one or more client systems..."

Claim Rejections - 35 USC § 112

9.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10.   Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "receiving a request for the download of a copy of at least one software file from a client system" does not clearly indicate whether the request for the download is originating from the client system, or whether an external request is calling for the downloading of at least one software file *from* (emphasis added) a client system. As such, the claim as written is indefinite. For purposes of examination, the claim will be interpreted to read "receiving a request from a client system for the download of a copy of at least one software file"

11.   Claim 15 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

12.   Claim 15 recites the limitation "the file system" in line 8. There is insufficient antecedent basis for this limitation in the claim. For purposes of examination this will be interpreted to read "software file to a file system..."

Claim Rejections - 35 USC § 101

13.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 16 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The invention as disclosed in claims 1-32 is directed to non-statutory subject matter. The claimed invention as a whole must accomplish a practical application. That is, it must produce a "useful, concrete and **tangible** result." (State Street Bank & Trust Co. v. Signature Financial Group Inc., 149 F.3d at 1373, 47 USPQ2d at 1601-02.)

Specifically, the claims are directed to a structure of a software payload consisting of a number of software elements. However, these elements are not necessarily embodied in computer hardware, nor does the claim recite any useful, concrete and tangible result from the structure of this software payload. Thus, applicant fails to disclose that the payload is tangibly embodied and executed by a piece of hardware and that their functions have practical applications which produce useful, concrete, and tangible results under the State Street Formulation.

On this basis, claim 16 is rejected under 35 U.S.C. § 101.

Claim Rejections - 35 USC § 102

14.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

15.   Claims 1, 3-12 and 14-17 are rejected under 35 U.S.C. 102(e) as being anticipated by US

Publication 2002/0174422 A1 to Kelley et al, hereafter referred to as Kelley.

Per claim 1:

Kelley discloses:

- a method on a client server network for the ordering, downloading, and installing software
   (Note paragraph 0025)

- ordering at least one software file from a list of software on a software ordering server
   ("The...administrator can specify which vendor sites to monitor and which patches to
   collect..." in paragraph 0050)

- receiving a response to the order for at least one software file from the software ordering
   server, the response including an entitlement ID ("A cryptographic checksum for each file is
   also included in the patch..." in paragraph 0050)

- requesting a copy of the at least one software file from the software delivery server, the
   request includes the received entitlement ID ("From this information, the...Server can

determine which patches need to be installed on the target system…" in paragraph 0051.

The patches are requested from the vendor sites.)

- receiving the copy of the at least one software file from a scheduling server as part of a

    payload containing at least one customized installation script ("distributes needed patches as

    well as the appropriate installation script to client's systems…" in paragraph 0026)

- installing the received copy of the at least one software file under the direction of a

    scheduling server ("The…Server evaluates target systems on a scheduled basis and installs

    patches…" in paragraph 0048)

substantially as claimed.

Per claim 3:

The rejection of claim 1 is incorporated, and further, Kelley discloses sending a system platform

type, amount of available storage, and an identifier of other software installed as claimed (Note

paragraph 0042)

Per claim 4:

The rejection of claim 1 is incorporated, and further, Kelley discloses ordering from the software

ordering server only when the software file is needed as claimed ("automating the installation of

required security patches and related system software" in paragraph 0040)

Per claim 5:

The rejection of claim 1 is incorporated, and further, Kelley discloses the step of installing requiring

no further intervention from the software ordering server as claimed ("distributes needed patches as

well as the appropriate installation script to client's systems…" in paragraph 0026. The script

performs the installation; consequently, the server does not need to intervene.)

Per claim 6:

The rejection of claim 1 is incorporated, and further, Kelley discloses the step of installing requiring

no client user intervention by a user on the client system as claimed ("distributes needed patches as

well as the appropriate installation script to client's systems…" in paragraph 0026. The script

performs the installation; consequently, the user does not need to intervene.)

Per claim 7:

The rejection of claim 1 is incorporated, and further, Kelley discloses the step of installing not

allowing any choices or options by a user on the client system as claimed ("distributes needed

patches as well as the appropriate installation script to client's systems…" in paragraph 0026. The

script performs the installation; consequently, the user does not need to intervene and cannot

choose options during the installation.)

Per claim 8:

The rejection of claim 1 is incorporated, and further, Kelley discloses the step of installing obviating

the need for help to install, or questions about the installation of the at least one software file from a

help desk as claimed ("distributes needed patches as well as the appropriate installation script to

client's systems…" in paragraph 0026. The script performs the installation automatically with no

intervention, thereby inherently obviating the need for help to install or the need for a help desk.)

Per claim 9:

Kelley discloses:

- a method on a client server network for the selection, download and installation of software (Note paragraph 0025)

- receiving a request from a client system for the download of a copy of at least one software file ("will compare the target system's objects with the objects form the patch to determine what is actually installed and what needs to be installed..." in paragraph 0049. The client software will indicate what software is needed.)

- verifying the client system's PC compatibility for the requested copy of at least one software file ("then collects all of the patches from the patch spec database pertaining to this system's operating system, version, and architecture" in paragraph 0051)

- scheduling the download of the requested software to the client system ("distributes needed patches as well as the appropriate installation script to client's systems..." in paragraph 0026)

substantially as claimed.

Per claim 10:

The rejection of claim 9 is incorporated, and further, Kelley discloses requesting the client system's PC platform type, available storage, installed software, and verifying that one or more responses to the requests are within allowable limits as claimed (Note paragraph 0042. The system inherently verifies that the patch will work before installing.)

Per claim 11:

Kelley discloses:

- a method on a client server network for the ordering, deployment and installation of software (Note paragraph 0025)

- receiving an entitlement ID for at least one software file ("A cryptographic checksum for each file is also included in the patch..." in paragraph 0050)

- storing the entitlement ID for at least one software file in a database ("the patch spec database..." in paragraph 0051)

- receiving a request for the down load of at least one requested software file with a entitlement ID from a client ("then collects all of the patches from the patch spec database pertaining to this system's operating system, version, and architecture" in paragraph 0051. The ID information from the client is used to match the patches in the database)

- looking up the received entitlement ID in the database ("then collects all of the patches from the patch spec database pertaining to this system's operating system, version, and architecture" in paragraph 0051)

- finding the entitlement ID and the request for at least one software file in the data base ("then collects all of the patches from the patch spec database pertaining to this system's operating system, version, and architecture" in paragraph 0051)

- scheduling a response to the request for a copy of the at least one software file at a scheduling server ("distributes needed patches as well as the appropriate installation script to client's systems..." in paragraph 0026)

substantially as claimed.

Per claim 12:

Claim 12 is directed to a computer readable medium containing programming instructions for

performing the method of claim 1, and is rejected for the reasons set forth in connection with claim

1.

Per claim 14:

The rejection of claim 12 is incorporated, and further, note the rejection regarding claim 3.

Per claim 15:

Kelley discloses:

- a computer readable medium containing programming instructions for the ordering,

  deployment and installation of software over a client server network (Note paragraph 0025)

- receiving a request from a client system for a copy of at least one software file ("will

  compare the target system's objects with the objects form the patch to determine what is

  actually installed and what needs to be installed..." in paragraph 0049. The client software

  will indicate what software is needed.)

- building a payload of software commands and the at least one software file ("distributes

  needed patches as well as the appropriate installation script to client's systems..." in

  paragraph 0026)

- sending the payload of software commands and the at least one software file to a file system

  ("distributes needed patches as well as the appropriate installation script to client's

  systems..." in paragraph 0026)

- installing the at least one software file on the client system using the software commands in the client ("The...Server evaluates target systems on a scheduled basis and installs patches..." in paragraph 0048)

substantially as claimed.

Per claim 16:

Kelley discloses:

- a structure of a payload for the delivery of at least one software file ("distributes needed patches as well as the appropriate installation script to client's systems..." in paragraph 0026. The patch is inherently part of a payload, as it is transferred to the client system.)

- at least one software file ("distributes needed patches as well as the appropriate installation script to client's systems..." in paragraph 0026. The software file is part of the patch.)

- at least one installation script for at least one software file ("distributes needed patches as well as the appropriate installation script to client's systems..." in paragraph 0026.)

- at least one software key for the at least one software file for installing the one software file ("If checksum in patch specification..." in paragraph 0091. The checksum is a type of software key.)

- an overall installation script which controls the downloading and installation and file maintenance for the at least one software file ("distributes needed patches as well as the appropriate installation script to client's systems..." in paragraph 0026. The script performs maintenance checks to ensure that the patch should be installed on the client system.)

substantially as claimed.

Per claim 17:

Kelley discloses:

- a software staging server coupled to a client server network (Note Figure 1)

- a network interface for coupling one or more client systems (Note Figure 1)

- a request received over the network interface from at least one of the one or more client systems for a copy of at least one software file ("will compare the target system's objects with the objects form the patch to determine what is actually installed and what needs to be installed..." in paragraph 0049. The client software will indicate what software is needed.)

- a payload of software commands and the at least one software file, the payload sent over the network interface so that the at least one software file is installed on the at least one of the one or more client systems without further user intervention on the client system ("distributes needed patches as well as the appropriate installation script to client's systems..." in paragraph 0026. The script performs the installation; consequently, the user does not need to intervene.)

substantially as claimed.

Claim Rejections - 35 USC § 103

16.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

17.   Claims 2 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over US

Publication 2002/0174422 A1 to Kelley et al, hereafter referred to as Kelley in view of U.S. Patent

6,067,582 to Smith et al, hereafter referred to as Smith.

Per claim 2:

The rejection of claim 1 is incorporated, and further, Kelley does not explicitly disclose receiving a

request for acceptance of a software license agreement, and sending the acceptance to the software

delivery server. Smith discloses in an analogous client/server software distribution system the act of

requesting acceptance of a software license agreement, and sending the acceptance to the software

delivery server as claimed ("confirms acceptance of license terms and inputs user information, all of

which is then transferred back to the server module..." in col. 3 lines 21-23). It would have been

obvious to one of ordinary skill in the art at the time the invention was made to include the license

agreement ability of Smith with the software distribution system of Kelley, as this would enable a

vendor to impose legal standards on the to-be installed software in the system of Kelley.

Per claim 13:

The rejection of claim 12 is incorporated, and further, note the rejection regarding claim 3.

Conclusion

18.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Trent J Roche whose telephone number is (703)305-4627. The examiner can normally be reached on Monday - Friday, 9:00 am - 6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki can be reached on (703)305-9662. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Trent J Roche
Examiner
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TJR

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